

REMARKS

By this response, Applicants amend claims 1, 4-6, and 29 to more appropriately define the invention, and add new claims 30-34 to protect additional aspects of the invention. With claims 8-28 having been withdrawn from consideration, claims 1-7 and 29-34 are pending.

In the Office Action of March 24, 2004¹ (“OA”), claim 29 was allowed and claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,004 to *Good et al.* (“*Good*”) in view of U.S. Patent No. 5,770,841 to *Moed et al.* (“*Moed*”). Applicants acknowledge, with appreciation, the allowance of claim 29 and address the rejection (and new claims) as set forth below.

Rejection of claims 1-7 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 1-7 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Good* and *Moed*. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Independent claim 1, as currently presented, recites a method including “an image capture system for producing images of the objects.” *Good* fails to teach or suggest at least this claimed feature. While acknowledging (OA at 3) that *Good* fails to teach an image capture system, the Examiner relies on *Moed* in an attempt to establish *prima facie* obviousness.

A *prima facie* obviousness has not been established at least because the requisite motivation to combine the references and expectation of success are lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, there is no “substantial evidence” in the record to support the attempted combination of *Good* and *Moed*, and the requisite “clear and particular” motivation to support a *prima facie* case of obviousness is lacking. The Examiner does not show, by substantial evidence, that a skilled artisan having the cited references before him, and not having the benefit of Applicants’ disclosure, would have been motivated to combine those references in a manner resulting in Applicants’ claimed combination. The Examiner merely provides a description of how *Moed* allegedly teaches certain features not found in *Good* without a proper motive for combining that reference with *Good*.

The Examiner alleges (OA at 3):

It would have been obvious to one of ordinary skill in the art . . . to incorporate the image capture system as taught by *Moed* to the . . . system of *Good* in order to provide an improved and an enhanced means wherein operator(s) can verify the package in the scanning

terminal using the image of the package displayed on the display device.

The Examiner further alleges that the proposed combination “would provide an alternative means for reading/decoding the characters … from [a] package using the optical character recognition (OCR) techniques …” (OA at 4).

These conclusory statements in the Office Action are not properly supported by facts on the record and do not evidence that a skilled artisan would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination, absent Applicants’ disclosure. Neither *Good* nor *Moed* describes any such “alternative” reading/decoding means or “enhanced means” for enabling an operator to verify a package in a scanning terminal, as referred to in the Examiner’s rejection. *Good* does not teach or suggest allowing an operator to verify a package in a scanning tunnel using an image of the package. Further, while *Moed* describes reading and decoding bar codes, the reference fails to teach or suggest verifying a package in a scanning terminal.

Furthermore, *Good* teaches away from the Examiner’s alleged combination. Contrary to the Examiner’s assertions, *Good* does not teach or suggest the desirability of achieving “means wherein operator(s) can verify the package in the scanning terminal using the image of the package” (OA at 3). Rather, *Good* explicitly states: “[a]n object of the present invention is to provide an automated…system which…[does] not require any human intervention” (col. 4, lines 3-6 (emphasis added)). Moreover, the Examiner points to no evidence supporting the notion that a skilled artisan considering *Good* would have been concerned with enabling an operator to verify packages or providing an alternative means for reading and decoding. Indeed, the Examiner fails to show that either of the relied-upon references suggests combining their

teachings. For at least these reasons, the Examiner fails to meet the burden for establishing a *prima facie* case of obviousness.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” As explained above, the Examiner does not show that the cited art “suggests the desirability of the” combination. No objective reason for combining the applied art, other than the Examiner’s attempt to meet the terms of claim 1, has been established. One of ordinary skill in the art would have appreciated, at the time of the invention, that *Good* and *Moed* do not suggest the Examiner’s proposed combination, absent the benefit of Applicants’ disclosure.

Applicants note that the requirements for establishing *prima facie* obviousness must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001). As M.P.E.P. § 2142 articulates:

Knowledge of applicant’s disclosure must be put aside....
[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to reconstruct the prior art. A skilled artisan would not have been motivated, without consulting Applicants’ disclosure, to combine the teachings of *Good* and *Moed*. Neither of these references teaches or suggests combining their respective teachings as alleged in the Office Action. Although *Good* discloses a package identification and measuring system, *Good* does not teach or suggest allowing an operator to verify a package in a scanning tunnel using an image of the package. Further, while *Moed* describes a system for reading and decoding bar codes, *Moed*

does not teach or suggest verifying a package in a scanning terminal. Indeed, neither of the references suggests combining their teachings to achieve “alternative” reading/decoding means or “enhanced means” for enabling an operator to verify a package in a scanning terminal. The conclusions in the Office Action, therefore, constitute improper hindsight reasoning.

For at least the reasons advanced above, the requisite motivation to combine is lacking. Moreover, the Examiner has not shown, by substantial evidence, that there is a reasonable expectation of success in combining *Good* and *Moed*. The Examiner has not shown that the alleged combination would be feasible given the disclosures of the references.

Because the required motivation to combine the applied references is lacking, and since the applied references (even if combined) fail to teach or suggest each and every claim recitation, *prima facie* obviousness has not been established with respect to claim 1. The rejection of claim 1 under 35 U.S.C. § 103(a) should therefore be withdrawn. Claims 2-7 depend from claim 1. A *prima facie* case of obviousness has not been established with respect to claims 2-7 for at least the reasons presented in connection with base claim 1.

Moreover, dependent claim 5 recites an object identification system for producing object identification information for the objects, “wherein the object identification system comprises at least one scanner operable to focus based on the object dimension information.” *Good* fails to teach or suggest at least this claimed feature.

More specifically, the Examiner alleged that *Good* discloses “a package identification subsystem for identifying the package by reading [a] barcode affixed on the package using a barcode reader” (OA at 2). Although *Good* discloses a package identification and measuring system, the reference does not teach or suggest at least an object identification system comprising “at least one scanner operable to focus based on the object dimension information,”

as recited in claim 5. Instead, *Good* mentions an “omni-directional holographic scanning tunnel” for reading bar codes on packages (col. 2, lines 8-20 (emphasis added)). *Good* explains that the scanning system scans for bar coded symbols “regardless of the position of the [bar code symbol] on the ...product” (col. 28, lines 25-30). Rather than focusing scanning means based on object dimension information, *Good*’s system uses “an arrangement” of laser scanners which “form a ‘tunnel’ scanning subsystem over and about the conveyor belt” to achieve “omnidirectional scanning performance” (col. 14, lines 16-26; col. 15, lines 37-44; *see FIGS. 5A-9B*). An omnidirectional scanning tunnel, as described by *Good*, does not teach or suggest an object identification system comprising “at least one scanner operable to focus based on the object dimension information,” as recited in claim 5.

Moed fails to cure these deficiencies of *Good*. *Moed* describes a system for reading and decoding bar codes from packages and verifying the accuracy of destination addresses. *Moed*’s system includes a camera 16 to “capture an image of the top surface of the package...” and a label decoding system 14 that “locates and decodes machine readable package identification data and destination address data contained in the image” (col. 5, lines 15-30). *Moed* does not teach or suggest at least an object identification system comprising “at least one scanner operable to focus based on the object dimension information,” as recited in claim 5. Instead of using a scanner operable to focus based on object dimension information, *Moed*’s system captures an image of a package and then “processes the image and decodes the bar code ...” (col. 3, lines 58-62). Indeed, *Moed* does not disclose a scanner, let alone a scanner operable to focus based on object dimension information, as recited in claim 5.

Good and *Moed* therefore fail, alone and in combination, to teach or suggest each and every element recited in claim 5. In addition, the requisite motivation to combine the references

and expectation of success are lacking with respect to claim 5 for at least the reasons advanced above in connection with base claim 1. Because the required motivation to combine the applied references is lacking, and since the applied references (even if combined) fail to teach or suggest each and every claim recitation, *prima facie* obviousness has not been established with respect to claim 5.

Because *prima facie* obviousness has not been established with respect to claims 1-7, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn. Accordingly, Applicants request withdrawal of the rejection of claims 1-7 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

New claims

New claims 30-34 depend, either directly or indirectly, from base claim 1. For at least the reasons presented above in connection with claim 1, new claims 30-34 are not anticipated or rendered obvious by *Good* and *Moed*. Applicants further submit that neither *Good* nor *Moed*, nor any combination thereof, teaches or suggests all of the features recited in new claims 30-34. Applicants therefore request the timely allowance of the new claims.

Conclusion

The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner's reconsideration of the application in view of the remarks presented herein, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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